

20. (Currently Amended) The method according to claim 12, wherein the act of instructing the apparatus to capture, together with the imager, at least one of a) a streaming video digital image of the individual at the [a] first location and [or] b) a still digital image of the individual at the [a] first location comprises an act of instructing the apparatus to capture, together with the imager, a streaming video digital image of the individual at the [a] first location.

REMARKS

In response to the Final Office Action dated May 7, 2003, Applicant respectfully requests reconsideration. To further the prosecution of this application, the Applicant herewith submits a Request for Continued Examination and this Preliminary Amendment. Claims 1-20 were previously pending in this application. By this Preliminary Amendment, Applicant is amending claims 1, 6, 12 and 14-20. Claims 1-20 are pending for examination with claims 1 and 12 being independent claims. No new matter has been added. The rejections raised in the Final Office Action are addressed below. The application is believed to be in condition for allowance.

Telephone Interview Summary

Initially, the Applicant's representative thanks Examiner Bali for his courtesy during the Telephone Interview on June 18, 2003, the substance of which is summarized below. During the Telephone Interview, Applicant's representative again submitted that the rejection of claims 1-20 under 35 U.S.C. § 103 as being unpatentable over Wang in view of Musgrave in the May 7, 2003 Office Action is improper because the resulting combination would be unsatisfactory for its intended purpose. According to MPEP § 2143.01, it is improper to reject the claims under 35 U.S.C. § 103 if the proposed modification would render the prior art unsatisfactory for its intended purpose.

During the Telephone Interview, Applicant's representative described Wang and Musgrave and stated that the references could not be combined in the manner suggested. More particularly, the personal identifier and management system of Wang is designed to aid a user in recalling names of previously met people. The system of Wang includes a device that captures an image of a person and then compares it to stored images. If no match is obtained, the device gives the user the option of storing the captured image, along with person-identifying data. (See col. 6, lines 1-11).

Conversely, Musgrave teaches a cellular phone that will not allow calls to be placed unless the user's identification information is matched with authorized user information. If the identifying information is not matched, no signal is sent to the phone to authorize use of the phone, and the phone remains locked.

If the identification system of Musgrave were employed on the Wang device, and the identifying information were transmitted to a remote location and the person being identified was not in the database, then the modified Wang system would remain locked and the user would be unable to store any identifying information about the new individual. Such a system would defeat one of the stated purposes of the Wang system, namely, the ability to operate the Wang device to load the desired information.

During the Telephone Interview, the Examiner responded that he may pick only part of the prior art teaching and not necessarily the entire teaching to render the rejection, and that he relies on Musgrave only to teach transmission of identifying information. Applicant's representative pointed out that the reliance on only part of Musgrave, while ignoring other parts that indicate that the proposed combination would render the prior art unsatisfactory for its intended purpose, was improper.

Although not discussed during the Telephone Interview, Applicant now refers to MPEP §2141 (on page 2100-116), which states,

“When applying 35 USC §103, the following tenets of patent law must be adhered to: ... (B) the references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination.” (Emphasis added)

In addition, the Federal Circuit and its predecessor court have repeatedly indicated that when performing an obviousness analysis under §103, each reference must be considered in its entirety to determine whether it fairly suggests that the invention as a whole is obvious. See e.g., Bausch&Lomb v. Barnes-Hind/Hydrocurve, 230 USPQ 416, 419 (Fed. Cir.1986) (“it is impermissible within the framework of §103 to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one skilled in the art.”); In re Kuderna and Phillips, 165 USPQ575, 578-579 (CCPA 1970) (stating that the issue of what would have been

obvious to one of ordinary skill in the art must be made “in view of the *sum* of all the relevant teachings in the art, not in view of first one and then another of isolated teachings in the art.”).

Thus, when the references are considered as a whole, it becomes clear that the proposed modification would render the prior art invention unsatisfactory for its intended purpose, as discussed above. Accordingly, the rejection of claim 1 as being unpatentable over Wang in view of Musgrave should be withdrawn.

Applicants representative also explained during the Telephone Interview that even if the two references are combined, they do not teach all of the limitations in pending claim 1. More specifically, the resulting combination would not include a receiver coupled to the computer and adapted to receive instructions from the second location, with the instructions comprising an action the user of the apparatus should take regarding the individual.

The Examiner indicated during the Telephone Interview that he would consider a claim amendment to more particularly define the instructions that are to be transmitted to the hand-held apparatus.

Claim Rejections - 35 U.S.C. §103

Claims 1-20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Wang (U.S. Pat. No. 6,038,333) in view of Musgrave et al. (U.S. Pat. No. 6,377,699). This rejection is traversed for the reasons set forth above and for the following reasons.

A. Motivation Not Proper

To establish a *prima facie* case of obviousness, there must be a suggestion or motivation to modify the reference or to combine reference teachings (MPEP §2142). In the Office Action, the Examiner contends that it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the two references because “they are analogous because they are solving [the] same problem of identifying the individuals.” (Office Action dated May 7, 2003, page 3).

The mere fact that two references are analogous or solve the same problem does not provide a motivation to combine the two references. Rather, under the law, the prior art *must suggest* the desirability and thus the obviousness of making the combination, not just that the references are analogous. Considering whether the prior art is analogous is a threshold inquiry –

analogous art relates to whether the prior art is available or can be relied upon, *not* to whether prior art references are combinable.

Because no suggestion or motivation to combine the references has been provided, a *prima facie* case of obviousness has not been established, and Applicant respectfully submits that the rejection be withdrawn. If the Examiner is to maintain this rejection, Applicant respectfully requests that the Examiner point to some teaching or motivation in the prior art to combine the references in the manner suggested.

B. Resulting Combination Does Not Teach or Suggest All the Limitations of the Claim

Even if one were to modify Wang with the transmitting and receiving features of Musgrave, the resulting combination would not include all the limitations of amended claim 1. As amended, claim 1 recites, *inter alia*, “a receiver coupled to the computer and adapted to receive instructions from the second location, the instructions comprising an action the user of the apparatus should perform regarding the individual, the action comprising one of allowing and denying the individual access to the designated area”. Support for this amendment may be found, for example, on page 30, lines 26-28 and on page 31, lines 12-14. Nothing in the prior art of record teaches or suggests such a limitation. Accordingly, withdrawal of this rejection is respectfully requested. Claims 2-11 depend directly or indirectly from claim 1 and therefore are believed to be allowable as well.

Claim 12 stands rejected under 35 USC §103(a) as being unpatentable over Wang in view of Musgrave et al. Applicant maintains that the combination of Wang and Musgrave is improper, as discussed above. Nevertheless, Applicant has amended claim 12 to recite, “obtaining instructions . . . the instructions comprising an action the user of the apparatus should perform regarding the individual.” Support for this amendment may be found, for example, on page 31, lines 12-14. None of the prior art of record teaches or suggests such a limitation. Accordingly, withdrawal of this rejection is respectfully requested. Claims 13-20 depend directly or indirectly from claim 12, and therefore are believed to be allowable as well.

CONCLUSION

In view of the foregoing amendments and remarks, this application should now be in condition for allowance. A notice to this effect is respectfully requested. If the Examiner

believes, after this amendment, that the application is not in condition for allowance, the Examiner is requested to call the Applicant's representative at the telephone number listed below.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicant hereby requests any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, that is not covered by an enclosed check, please charge any deficiency to Deposit Account No. 23/2825.

Respectfully submitted,
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